IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Group Art Unit: 2143
)	
Louis Bouchard *et al.*)	Examiner: Dennison, Jerry
)	
Serial No.: 09/697,113)	**TRANSMITTAL LETTER**
)	
Filed: 10/25/00)	162 North Wolfe Road
)	Sunnyvale, California 94086
For: **INSTANT MESSAGE**)	(408) 530-9700
NOTIFICATION APPLICATION)	
)	Customer Number 28960

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed please find an Appeal Brief and a check in the amount of $500.00 to cover the surcharge for filing with the U.S. Patent and Trademark Office. Also attached is U.S. Patent No.6,535,586, U.S. Patent No. 6,449,344, and copies of office actions dated; April 15, 2004, October 6, 2004 and June 15, 2004.

The Commissioner is authorized to charge any additional fee or credit any overpayment to our Deposit Account No. <u>08-1275</u>. **An originally executed duplicate of this transmittal is enclosed for this purpose.**

Respectfully submitted,

HAVERSTOCK & OWENS LLP

Dated: <u>December 15, 2004</u>   By: <u>Thomas B. Haverstock</u>
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- 1 -

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PATENT

Atty. Docket No.: AVALUC-01701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	Group Art Unit: 2143
	)	
Louis Bouchard	)	Examiner: Dennison, Jerry
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Serial No.: 09/697,113	)	
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Filed: October 25, 2000	)	**APPEAL BRIEF**
	)	
For: **INSTANT MESSAGE**	)	
NOTIFICATION APPLICATION	)	
	)	162 N. Wolfe Rd.
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

      In furtherance of patent owner's Notice of Appeal filed on October 15, 2004, an Appeal Brief is submitted herewith in triplicate. This Appeal Brief is written in support of the patent owner's Notice of Appeal filed on October 15, 2004, and further pursuant to the rejection mailed on April 15, 2004 (Office Action of same date), and mailed on October 6, 2004 (Advisory Action of same date).

      Claims 1, 3-20, and 22-27 have been rejected. The appellant submits this brief to the Board of Patent Appeals and Interferences in compliance with the requirements of 37 C.F.R. § 41.37, as stated in *Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule)*, 69 Fed. Reg. 49959 (August 12, 2004). The appellant contends that the rejection of Claims 1, 3-20, and 22-27 in this pending application is in error and is overcome by this appeal.

I.   REAL PARTY IN INTEREST

As the assignees of the entire right, title and interest in the above-captioned patent application, the real parties in interest in this appeal are the following parties:

Avaya, Inc.
211 Mount Airy Road
Basking Ridge, New Jersey 07920

per the assignment document recorded on March 2, 2001, at reel number 011354 and frame number 0502.

II.   RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to the present patent application of which appellant is aware.

III.   STATUS OF CLAIMS

Claims 1, 3-20, and 22-27 are pending within this application. Claims 1, 3-20, and 22-27 stand rejected under 35 U.S.C. § 103(a).

The rejections of Claims 1, 3-20, and 22-27 are being appealed.

IV.   STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Advisory Action of October 6, 2004. The present condition of the claims is as listed in the Amendment and Response to Final Office Action filed on June 15, 2004.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

The elements of Claim 1, directed to one embodiment of the present invention, are described in the Present Specification on page 4, lines 9-29. Claim 1 is directed to a method of providing message notification for a user. The claimed method steps are directed to the system illustrated in Figure 1. The method includes the step of coupling a message notification application 10 to a server 12. The server 12 stores messages for the user. The method also includes the steps of registering the message notification application 10 to at least one instant messaging service 14, accessing one of the at least one instant messaging service 14 by the user, and signing the user onto the message notification application 10 by adding the user to a buddy

list of the message notification application 10 thereby associating the user to the one instant messaging service 14 which the user is currently accessing. The method also includes the step of sending an instant message notification from the message notification application 10 via the one instant messaging service 14 to the user when a message arrives on the server 12 for the user.

The elements of Claim 8, directed to another embodiment of the present invention, are described in the Present Specification on page 3, line 24 to page 4, line 3. Claim 8 is directed to an apparatus for providing message notification and allowing a user to instantly review new messages. The apparatus comprises at least one instant messaging service 14, a message notification application 10, a server 12, and an internet appliance 18. The message notification application 10 is registered to the at least one instant messaging service 14, wherein the message notification application 10 includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service 14 that the user is currently using. The server 12 stores messages and provides a medium for the message notification application 10 to operate. The internet appliance 18 accesses the server 12 and receives an instant message notification from the message notification application 10 via the one instant messaging service 14, the instant message notification indicates that a new message is stored on the server 12 for the user.

The elements of Claim 14, directed to another embodiment of the present invention, are described in the Present Specification on page 3, line 24 to page 4, line 3. Claim 14 is directed to a message notification system that allows the user to instantly review new messages. The message notification system comprises at least one instant messaging service 14, a message notification application 10, a server 12, and an internet appliance 18. The message notification application 10 is registered to the at least one instant messaging service 14, wherein the message notification application 10 includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service 14 that the user is currently using. The server 12 stores messages and provides a medium for the message notification application 10 to operate. The internet appliance 18 accesses the server 12 and receives an instant message notification from the message notification application 10 via the one instant messaging service 14, the instant message notification indicates that a new message is stored on the server 12 for the user.

The elements of Claim 20, directed to another embodiment of the present invention, are described in the Present Specification on page 3, line 24 to page 4, line 3, and the accompanying Figure 1. Claim 14 is directed to a message notification system for a user. The message notification system comprises means for coupling a message notification application 10 to a

server 12, wherein the server 12 stores messages for the user. The means for coupling, as set forth in the Present Specification, page 4, lines 4-8, includes the message notification application 10 and the server 12 as two separate physical components (Figure 1), or in the same location (Figure 2). The message notification system also comprises means for registering the message notification application 10 to at least one instant messaging service 14 (as set forth in the Present Specification on page 3, lines 26-28), means for accessing one of the at least one instant messaging service 14 by the user (as set forth in the Present Specification on page 4, lines 9-14), and means for signing the user onto the message notification application 10 by adding the user to a buddy list of the message notification application 10 thereby associating the user to the one instant messaging service 14 which the user is currently accessing (as set forth in the Present Specification on page 3, lines 28-30, and page 4, lines 18-27). The message notification system also includes means for sending an instant message notification from the message notification application 10 via the one instant messaging service 14 to the user when a message arrives on the server 12 for the user (as set forth in the Present Specification on page 4, lines 22-24 and lines 28-30).

The elements of Claim 27, directed to one embodiment of the present invention, are described in the Present Specification on page 4, lines 9-29. Claim 27 is directed to a method of providing a voice messaging notification application for a user in an instant messaging system. The method includes the steps of coupling a message notification application 10 to a server 12. The server 12 stores messages for the user. The method also includes the steps of registering the message notification application 10 to at least one instant messaging service 14, accessing one of the at least one instant messaging services 14 by the user, and adding the user to a buddy list of the message notification application 10. The buddy list is associated with the one instant messaging service 14. The method also comprises the steps of sending an instant message notification to the user from the message notification application 10 via the one instant messaging service 14 when a message arrives on the server 12 for the user, and allowing the user access to the server 12 by one of using an internet appliance 18 and using a telephone (Present Specification, page 5, lines 4-5).

VI.   ISSUES

The issues presented by the appellant for review by the Board of Patent Appeals and Interferences are as follows:

1.   Whether the Claims 1, 3-20, and 22-27 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,535,586 issued to Cloutier et

al. (hereafter "Cloutier") in view of U.S. Patent No. 6,449,344 issued to
Goldfinger et al. (hereafter "Goldfinger").

VII. ARGUMENT

A. Claims 1, 3-20, and 22-27 are Patentable over Cloutier in view of Goldfinger

Within the Office Action, Claims 1, 3-20, and 22-27 have been rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Cloutier in view of Goldfinger.

Cloutier teaches a system to provide messaging services to alert a message service
subscriber to the receipt of a high priority message and to provide the remote retrieval thereof.
An email server 110 stores email messages received over the internet 130 (Cloutier, col. 1, lines
26-27). A messaging system server 120 provides access to the email server 110 via the internet
130 such that notification of high priority email messages received on the email server 110 are
provided by transmitting a wireless message to a wireless device 170 used by the subscriber
(Cloutier, col. 3, lines 62-66). The messaging system server 120 periodically polls the email
server 110 for new messages, and if a new message is received, then a unique message code
corresponding to the new message is generated by the messaging system server 120 (Cloutier,
col. 4, line 63 to col. 5, line 4). The unique message code is sent from the messaging system
server 120 to the wireless device 170 used by the subscriber (Cloutier, col. 5, lines 17-22). To
retrieve the new message, the subscriber accesses the messaging system server 120 using an
access device 190 connected via a user interface 140 (Cloutier, col. 4, lines 26-38).

Goldfinger teaches a communications system for locating a user who is connected to a
communications network. A first user 18 accesses a communications network 14 via a terminal
12 (Goldfinger, col. 5, lines 24-27). Once user 18 is connected to the network 14, a connection
notification apparatus 30 notifies a connection monitor 22 that user 18 is connected to network
14 (Goldfinger, col. 5, lines 37-40). The connection notification apparatus 30 is included in the
terminal 12, and the connection monitor 22 is part of a server 20, the server 20 also connected to
the network 14 (Goldfinger, Figure 1). An information apparatus manager 28 is also included
within the server 20 and maintains a list of all users currently connected, also referred to as on-
line, to the network 14 (Goldfinger, col. 5, line 61 to col. 6, line 2). A list of sought users which
the user 18 is interested in communicating with is provided by the user 18 to the information
apparatus manager 28 (Goldfinger, col. 6, lines 3-5). The information apparatus manager 28
determines if any of the sought users are currently connected to the network 14 (Goldfinger, col.
6, lines 13-18). If a sought user is connected, the information apparatus manager 28 causes an

annunciator 24 to transmit an annunciation to user 18 (Goldfinger, col. 6, lines 19-24). The annunciator 24 is also included within the server 20 (Goldfinger, Figure 1). The annunciation is then sent to the user 18 (Goldfinger, col. 6, lines 42-48). In other words, the server 20, which includes the information apparatus manager 28 and the annunciator 24, generates the annunciation and sends the annunciation to the user.

The claimed invention is directed to an apparatus for and a method of providing message notification for a user through an instant messaging service. A message notification application 10 is registered to an instant messaging service 14 through an IP Network 16 such as the Internet or a private intranet (Present Specification, page 3, lines 26-28). The message notification application 10 maintains a buddy list corresponding to the instant messaging service 14 (Present Specification, page 4, line 20). In the case of multiple internet messaging services, a separate buddy list for each instant messaging service is maintained by the message notification application 10 (Present Specification, page 4, lines 24-27). When a number of users utilizing various instant messaging services 14 are signed up for the message notification application 10, the message notification application 10 can be registered with multiple instant messaging services 14 to enable it to communicate with users regardless of the instant messaging service 14 being utilized (Present Specification, page 3, line 33 to page 4, line 3). When the user logs onto the instant messaging service 14 using a particular internet appliance 18, the user instructs the message notification application 10 that the user desires to be notified when a new mail message is received by a message server (Present Specification, page 4, lines 18-20). The message notification application 10 then adds the user to the buddy list corresponding to the instant messaging service 14 currently used by the user (Present Specification, page 4, line 20).

The message notification application 10 operates on, or is coupled to, one of an application, voice messaging or unified server 12, hereinafter referred to as message server 12 (Present Specification, page 4, lines 4-5). When a new mail message is received by the message server 12, the message notification application 10 sends an instant message notification via the instant messaging service 14 for delivery to the user (Present Specification, page 3, lines 11-13 and page 4, lines 28-29). The instant messaging service 14 transmits the instant message notification to the internet appliance 18 currently used to access the instant messaging service 14 by the user (Present Specification, page 5, lines 12-16). The message notification application 10 does not directly transmit the instant message notification to the end user; instead, the message notification application 10 determines the proper instant messaging service 14 according to the buddy list currently listing the end user and then sends a message notification to the determined instant messaging service 14. In turn, the instant messaging service 14 sends an instant message

notification to the user. In this manner, the message notification application 10 functions as an interface between the message server 12 and the instant messaging service 14. As an interface, the message notification application 10 functions in a transparent manner such that the instant messaging service 14 perceives the message server 12 as another end user.

Within the present specification, a clear distinction is made between "instant message notifications" and "messages" (also referred to as "mail messages"). "Messages" are those data that are addressed to a particular end user and are stored on the message server 12. Examples of such "message" types include email messages, voice mail messages, and fax mail messages (Present Specification, page 5, lines 8-11). Users can be notified of received "messages" using different types of conventional "message notification systems", such as a "message waiting" indication light on a phone, "stutter" dial tone on a home phone, an icon or short message on a wireless handset's display, a numeric message to a pager and numerous others (Present Specification, page 2, lines 20-25). In contrast, "instant message notifications" are those data that are addressed to a particular end user and are instantly communicated to the particular user via a pop up box on the user's screen (Present Specification, page 1, lines 22-26). "Instant message notifications" are utilized within an Instant Messaging Service, which are well known in the art. Examples of specific Instant Messaging Services include AOL Instant Messenger®, MSN Messenger®, Yahoo! Messenger®, ICQ® or any privately-provided instant messaging service (Present Specification, page3, lines 30-33). It is well known in the art that "messages" and "message notification systems" are different than "instant messaging notifications" and "instant messaging services".

The appellant contends that Claims 1, 3-20, and 22-27 are patentable over Cloutier in view of Goldfinger for at least the following reasons:

1.   There is not proper motivation to combine the communication system of Goldfinger with the messaging system of Cloutier. Within the Office Action mailed on April 15, 2004 (hereafter "Office Action"), and again within the Advisory Action mailed on October 6, 2004 (hereafter "Advisory Action"), column 1, lines 45-47 of Cloutier is cited as motivation to add the communication system of Goldfinger to the messaging system of Cloutier. Column 1, lines 45-47 of Cloutier teaches that "the lack of an instant or direct notification upon the receipt of a message is a significant shortcoming of many messaging system." However, "notification", as cited, refers in a general sense to "messaging systems", the same type of messaging systems described above (section V, "Summary of the Invention") where "messages" refer to email, voice mail, or fax messages(see Cloutier, col. 1, lines 55-58), and "message notification systems" are for example pagers (see Cloutier, col. 1 lines 48-52). The appellant agrees that improvement to

the current state of message notification systems is needed. However, this is broad territory to cover and hardly a motivation to combine any possible function within a conventional message notification system. The present specification is directed to providing message notification advantages over conventional message notification systems and <u>to providing the additional benefit of re-directing the message notifications to whatever device the user is currently using</u>. The present invention provides both benefits by incorporating an Instant Messaging Service. Cloutier does not address the problem of re-directing a message notification to whatever device is currently being used by the user. Therefore, since this problem is not addressed within Cloutier, there is no motivation to combine an Instant Messaging Service within the messaging system of Cloutier. Moreover, there is no specific motivation to select the device the user is then using. In fact, although Cloutier teaches the need for a complementary system through which a user can retrieve an electronic message remotely (Cloutier, col. 2, lines 6-8), subsequent discussion of such a complementary system does not hint at, teach or suggest the implementation of an Instant Messaging Service.

        2.   The proposed combination of Cloutier in view of Goldfinger does not result in a viably functioning system. Within the Office Action, it is stated that the message server 12 of the present application is the same as the server 110 of Cloutier, that the message notification application 10 of the present application is the same as the messaging system server 120 of Cloutier, that the instant messaging service 14 of the present application is the same as the server 20/ network 14 of Goldfinger, and that the internet appliance 18 of the present application is the same as the end user terminals 12,16 of Goldfinger. In column 2, lines 34-41, Cloutier teaches that to notify a user that a message has been received at the server 110, the messaging system server 120 generates a unique message code and transmits this code to the end user. However, Cloutier also specifically teaches that transmission of the code is made "using any number of real time delivery device such as a pager, computer connected over a network such as the internet, a PCS phone with SMS messages, etc." This is the exact type of conventional delivery means that the present invention is designed to overcome. On page 2, lines 20-25 of the present specification, such conventional delivery means are referred to as "message notification systems" which include sending numeric messages to a pager, just as Cloutier teaches sending a unique message code to a pager. In contrast, the present invention includes a method of providing message notification for a user through an Instant Messaging Service (Present Specification, page 3, lines 5-6). As described in detail above, an Instant Messaging Service is not the same as a message notification system. Cloutier specifically teaches the use of a message notification system, which teaches away from the present invention, and by extension teaches away from any

combination using an instant messaging service, such as that described in Goldfinger. Since Cloutier teaches away from the type of messaging system taught in Goldfinger, the proposed combination of Cloutier and Goldfinger is not a viable combination.

3.   Neither Cloutier, Goldfinger, nor their proposed combination teaches "registering a message notification application to at least one instant messaging service", as claimed. Goldfinger is not cited for teaching this limitation. Within the Office Action, it is stated that Cloutier does teach this limitation. Specifically, column 4, lines 15-25 of Cloutier is cited to support this assertion. However, the cited passage of Cloutier teaches a messaging system server 120 sending a message notification over the internet 130 to a personal computer 190. In other words, Cloutier teaches sending a notification to an end user access device. Clearly, "sending a notification" and "registering with a service" is not the same. Further, there is no hint, teaching , or suggestion of registering a notification application, such as the messaging system server 120, to a messaging service, such as an instant messaging service, as claimed. Within the Advisory Action, it is stated that Cloutier teaches a system for notification of electronically stored messages for subscribers, where it is inherent that a registration process must be performed. The appellant respectfully disagrees with the conclusion that any inherent registration process is directed to registering a message notification system with an instant messaging service. If Cloutier does imply any registration process, which the appellant does not believe to be the case, then such an implication would be for the subscriber to be registered with the messaging system server 120. However, this is not what is claimed. It is specifically claimed that a message notification application is registered to an instant messaging service. There is no hint, teaching, suggestion, or implication within Cloutier to suggest that the messaging system server 120 is registered to any type of service, let alone an instant messaging service.

4.   Neither Cloutier, Goldfinger, nor their proposed combination teaches "signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing". Within the Office Action, it is stated that Goldfinger does teach this limitation. Specifically, column 6, lines 3-35 of Goldfinger is cited to support this assertion. The cited portion of Goldfinger teaches a server 20 that includes an information management apparatus 28 that maintains a list of users connected to the internet 14. In short, an active user list is maintained on the server 20 of Goldfinger. In direct contrast, the claimed limitation is directed to "adding the user to a buddy list of the message notification application" (emphasis added). As discussed above in part 2 of this section, within the Office Action a comparison is made in which the message notification application 10 of the present invention is asserted to be the same as the

messaging system server 120 of Cloutier, and the instant messaging service 14 of the present invention is asserted to be the same as the server 20/network 14 of Goldfinger. If this comparison is valid, which the appellant does not believe to be the case, then the claimed buddy list (of the message notification application 10) would be maintained on the messaging system server 120 of Cloutier. However, as previously discussed, Goldfinger teaches maintaining the active user list on the server 20. As such, the proposed combination of Goldfinger and Cloutier would maintain the active user list on the server 20 of Goldfinger, not on the messaging system server 120 of Cloutier as asserted within the Office Action. Therefore, maintaining an active user list on the server 20, as taught by Goldfinger, is not the same as maintaining a buddy list on the message notification application 10, as claimed.

Further, within the Advisory Action, it is stated that Cloutier teaches "a list of subscribers to the message notification system where the subscribers must provide a password to retrieve stored messages." It is asserted that such a list of subscribers is the same as the claimed "signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing." To support this assertion, column 5, lines 25-40 of Cloutier is cited. In column 5, lines 25-40, Cloutier teaches that the messaging system server 120 maintains a database of information regarding each subscriber. However, such a registration database is well known in the art and is used to maintain a list of subscriber information, where the information was provided by the subscriber during a previous registration process. Such a registration database does not include information regarding whether or not the subscriber is currently logged onto the service. In contrast, the claimed limitation is directed to adding the user to a buddy list thereby associating the user to the one instant messaging service which the user is currently accessing. Clearly, maintaining a registration database, as taught by Cloutier, is not the same as maintaining a list of users currently accessing a service.

Claims 1 and 3-7

The independent Claim 1 is directed to a method of providing message notification for a user. The method includes coupling a message notification application to a server, wherein the server stores messages for the user, registering the message notification application to at least one instant messaging service, accessing one of the at least one instant messaging service by the user, signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing, and sending an instant message notification from the

message notification application via the one instant messaging service to the user when a message arrives on the server for the user. As discussed above, there is not proper motivation to combine the communication system of Goldfinger with the messaging system of Cloutier. Further, the proposed combination of Cloutier in view of Goldfinger does not result in a viably functioning system. Still further, neither Cloutier, Goldfinger, nor their proposed combination teaches registering a message notification application to at least one instant messaging service. Still yet further, neither Cloutier, Goldfinger, nor their proposed combination teaches signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing. For at least these reasons, the independent Claim 1 is allowable over the combination of Goldfinger with Cloutier.

Claims 3-7 are dependent on independent Claim 1. As stated above, Claim 1 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 3-7 are also allowable as being dependent on an allowable base claim.

Claims 8 and 9-13

The independent Claim 8 is directed to an apparatus for providing message notification and allowing a user to instantly review new messages. The apparatus comprises at least one instant messaging service, a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using, a server for storing messages and providing a medium for the message notification application to operate, and an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user. As discussed above, there is not proper motivation to combine the communication system of Goldfinger with the messaging system of Cloutier. Further, the proposed combination of Cloutier in view of Goldfinger does not result in a viable functioning system. Still further, neither Cloutier, Goldfinger, nor their proposed combination teaches registering a message notification application to at least one instant messaging service. Still yet further, neither Cloutier, Goldfinger, nor their proposed combination teaches signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing. For at least these reasons, the independent Claim 8 is allowable over the

combination of Goldfinger with Cloutier.

Claims 9-13 are dependent on independent Claim 8. As stated above, Claim 8 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 9-13 are also allowable as being dependent on an allowable base claim.

Claims 14 and 15-19

The independent Claim 14 is directed to a message notification system that allows the user to instantly review new messages. The message notification system comprises at least one instant messaging service, a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using, a server for storing messages and providing a medium for the message notification application to operate, and an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user. As discussed above, there is not proper motivation to combine the communication system of Goldfinger with the messaging system of Cloutier. Further, the proposed combination of Cloutier in view of Goldfinger does not result in a viable functioning system. Still further, neither Cloutier, Goldfinger, nor their proposed combination teaches registering a message notification application to at least one instant messaging service. Still yet further, neither Cloutier, Goldfinger, nor their proposed combination teaches signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing. For at least these reasons, the independent Claim 14 is allowable over the combination of Goldfinger with Cloutier.

Claims 15-19 are dependent on independent Claim 14. As stated above, Claim 14 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 15-19 are also allowable as being dependent on an allowable base claim.

Claims 20 and 22-26

The independent Claim 20 is directed to a message notification system for a user. The message notification system comprises means for coupling a message notification application to a server, wherein the server stores messages for the user, means for registering the message notification application to at least one instant messaging service, means for accessing one of the at

least one instant messaging service by the user, means for signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing, and means for sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user. As discussed above, there is not proper motivation to combine the communication system of Goldfinger with the messaging system of Cloutier. Further, the proposed combination of Cloutier in view of Goldfinger does not result in a viable functioning system. Still further, neither Cloutier, Goldfinger, nor their proposed combination teaches registering a message notification application to at least one instant messaging service. Still yet further, neither Cloutier, Goldfinger, nor their proposed combination teaches signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing. For at least these reasons, the independent Claim 20 is allowable over the combination of Goldfinger with Cloutier.

Claims 22-26 are dependent on independent Claim 20. As stated above, Claim 20 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 22-26 are also allowable as being dependent on an allowable base claim.

Claim 27

The independent Claim 27 is directed to a method of providing a voice messaging notification application for a user in an instant messaging system. The method comprises the steps of coupling a message notification application to a server, wherein the server stores messages for the user, registering the message notification application to at least one instant messaging service, accessing one of the at least one instant messaging services by the user, adding the user to a buddy list of the message notification application, wherein the buddy list is associated with the one instant messaging service, sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user, and allowing the user access to a server by one of using an internet appliance and using a telephone. As discussed above, there is not proper motivation to combine the communication system of Goldfinger with the messaging system of Cloutier. Further, the proposed combination of Cloutier in view of Goldfinger does not result in a viable functioning system. Still further, neither Cloutier, Goldfinger, nor their proposed combination teaches registering a message notification application to at least one instant messaging service.

Still yet further, neither Cloutier, Goldfinger, nor their proposed combination teaches signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing. For at least these reasons, the independent Claim 27 is allowable over the combination of Goldfinger with Cloutier.

B.   CONCLUSION

It is therefore respectfully submitted that Claims 1, 3-20, and 22-27 are allowable over the teachings of Cloutier in view of Goldfinger. Therefore, a favorable indication is respectfully requested.

VIII. APPENDIX

Claims Under Appeal

1. A method of providing message notification for a user comprising the steps of:

   a. coupling a message notification application to a server, wherein the server stores messages for the user;

   b. registering the message notification application to at least one instant messaging service;

   c. accessing one of the at least one instant messaging service by the user:

   d. signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing; and

   e. sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user.

2. (Canceled)

3. The method as claimed in claim 1 further comprising the step of retrieving the message by accessing the server.

4. The method as claimed in claim 3 wherein the server is one of an application, a voice messaging and a unified messaging server.

5. The method as claimed in claim 3 further comprising the step of accessing the server by

one of sending a request to the message notification application and using a telephone.

6.   The method as claimed in claim 3 further comprising the step of retrieving messages from the server by an internet appliance.

7.   The method as claimed in claim 3 further comprising the step of deleting a message using an internet appliance without retrieving the message from the server.

8.   An apparatus for providing message notification and allowing a user to instantly review new messages comprising:

a.   at least one instant messaging service;

b.   a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using;

c.   a server for storing messages and providing a medium for the message notification application to operate; and

d.   an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user.

9.   The apparatus as claimed in claim 8 further comprising means for automatically adding the user to the buddy list of the message notification application in response to the user signing up to receive messages with the message notification application.

10.   The apparatus as claimed in claim 8 wherein the message notification application

comprises means for sending the user the instant message notification through the one

instant messaging service when a message arrives for the user.

11.   The apparatus as claimed in claim 8 further comprising means for retrieving the message

from the server by one of sending a request to the message notification application and

using a telephone.

12.   The apparatus as claimed in claim 8 wherein the server is one of an application, a voice

messaging and a unified messaging server.

13.   The apparatus as claimed in claim 8 further comprising means for deleting the message

using the internet appliance without retrieving the message from the server.

14.   A message notification system that allows the user to instantly review new messages

comprising:

a.   at least one instant messaging service;

b.   a message notification application registered to the at least one instant messaging

        service, wherein the message notification application includes a buddy list onto

        which the user is added, thereby associating the user to one of the at least one

        instant message service that the user is currently using;

c.   a server for storing messages and providing a medium for the message notification

        application to operate; and

d.   an internet appliance to access the server and receive an instant message

        notification from the message notification application via the one instant

        messaging service, the instant message notification indicates that a new message is

stored on the server for the user.

15.   The message notification system as claimed in claim 14 further comprising means for automatically adding the user to the buddy list of the message notification application in response to the user signing up to receive messages with the message notification application.

16.   The message notification system as claimed in claim 14 wherein the message notification application comprises means for sending the user the instant message notification through the one instant messaging service when a message arrives for the user.

17.   The message notification system as claimed in claim 14 further comprising means for retrieving the message from the server by one of sending a request to the message notification application and using a telephone.

18.   The message notification system as claimed in claim 14 wherein the server is one of an application, a voice messaging and a unified messaging server.

19.   The message notification system as claimed in claim 14 further comprising means for deleting the message using the internet appliance without retrieving the message from the server.

20.   A message notification system for a user comprising:

      a.   means for coupling a message notification application to a server, wherein the server stores messages for the user;

      b.   means for registering the message notification application to at least one instant

messaging service;

c.   means for accessing one of the at least one instant messaging service by the user:

d.   means for signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing; and

e.   means for sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user.

21.   (Canceled)

22.   The message notification system as claimed in claim 20 further comprising means for the user to retrieve the message by accessing the server.

23.   The message notification system as claimed in claim 22 wherein the server is one of an application, a voice messaging and a unified messaging server.

24.   The message notification system as claimed in claim 22 wherein the user accesses the server by one of sending a request to the message notification application and using a telephone.

25.   The message notification system as claimed in claim 22 wherein the message is retrieved from the server by an internet appliance.

26.   The message notification system as claimed in claim 22 further comprising the step of deleting the message using the internet appliance without retrieving the message from the

server.

27. A method of providing a voice messaging notification application for a user in an instant messaging system comprising the steps of:

a. coupling a message notification application to a server, wherein the server stores messages for the user;

b. registering the message notification application to at least one instant messaging service;

c. accessing one of the at least one instant messaging services by the user;

d. adding the user to a buddy list of the message notification application, wherein the buddy list is associated with the one instant messaging service;

e. sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user; and

f. allowing the user access to a server by one of using an internet appliance and using a telephone.

X.   ATTACHMENTS

The following documents, which are part of the record, are attached for convenience:

1.   U.S. Patent No. 6,535,586 to Cloutier et al.
2.   U.S. Patent No. 6,449,344 to Goldfinger et al.
3.   The April 15, 2004 Office Action.
3.   The October 6, 2004 Advisory Action.
4.   The June 15, 2004 Amendment and Response to Final Office Action.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

Dated: 12 -15-04

By Thomas B. Haverstock

Thomas B. Haverstock
Reg. No. 32,571
Attorneys for Applicants

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,113	10/25/2000	Louis Bouchard	LUCENT-01701	3907

28960	7590	04/15/2004

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162 NORTH WOLFE ROAD
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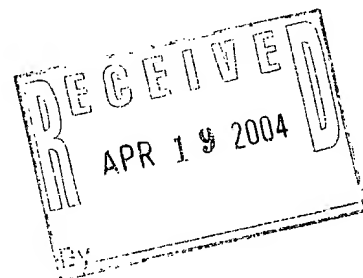| EXAMINER |
|---|
| DENNISON, JERRY B |

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 04/15/2004

docketed al.

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/697,113	BOUCHARD ET AL.
	Examiner	Art Unit
	J. Bret Dennison	2143

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 April 2004</u>.

2a)☒ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-20 and 22-27</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-20 and 22-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____ .

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5)☐ Notice of Informal Patent Application (PTO-152)

     Paper No(s)/Mail Date _____ .   6)☐ Other: _____ .

DETAILED ACTION

1.   This Action is in response to Amendment Paper #7 of Application Number

09/697,113 received on 01 April 2004.

2.   Claims 1, 3-20, and 22-27 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-20, and 22-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cloutier et al. (U.S. Patent Number 6,535,586), hereinafter referred

to by Cloutier, in view of Goldfinger et al. (U.S. Patent Number 6,449,344) hereinafter

referred to by Goldfinger.

3.   Regarding claims 1 and 20, Cloutier discloses a system and method of providing

message notification for a user comprising the steps of:

coupling a message notification application to a server, wherein the server stores

messages for the user (Cloutier, col. 3, lines 50-61);

registering the message notification application to at least one instant messaging

service (Cloutier, col. 4, lines15-25, Cloutier teaches a system for notification of

electronically stored messages that may be implemented using any type of devices

capable of receiving a message);

Cloutier also discloses alerting the user of the receipt of new messages, working

in conjunction with other messaging system architectures (Cloutier, col. 3, lines 33-41).

However, Cloutier does not disclose accessing one of the at least one instant

messaging service by the user;

signing the user onto the message notification application by adding the user to a

buddy list of the message notification application thereby associating the user to the one

instant messaging service which the user is currently accessing; and

sending an instant message notification from the message notification application

via the one instant message service to the user when a message arrives on the server

for the user.

In an analogous art of the networking field, Goldfinger discloses a communication

system using including accessing one of the at least one instant messaging service by

the user (Goldfinger, col. 5, lines 35-50, Goldfinger teaches notifying that the user is

connected to the system);

signing the user onto the message notification application by adding the user to a

buddy list of the message notification application thereby associating the user to the one

instant messaging service which the user is currently accessing (col. 6, lines 3-35,

Goldfinger teaches a server containing a list of connected users which updates the lists

of sought users predefined by users connected to the system); and

sending an instant message via the one instant message service to the user when a message arrives on the server for the user (col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine the system for notification and retrieval of electronically stored messages as disclosed by Cloutier, with the communication system using an instant messaging service as disclosed by Goldfinger to provide notification from the message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

4.   Regarding claims 3 and 22, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claim 1 and 20, including retrieving the message by accessing the server (Goldfinger, col. 6, lines 40-45, Goldfinger teaches the server sending a message after checking if the user is still connected).

5.   Regarding claims 4 and 23, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including wherein the server is one of an application, a voice messaging and a unified messaging server (Goldfinger, col. 5, lines 30-35).

6.   Regarding claims 5 and 24, Cloutier and Goldfinger show all of the features of

the invention, substantially as claimed, as described in claim 3 and 22, including

accessing the server by one of sending a request to the message notification

application and using a telephone (Goldfinger, col. 5, lines 24-30).

7.   Regarding claims 6 and 25, Cloutier and Goldfinger show all of the features of

the invention, substantially as claimed, as described in claim 3 and 22, including

retrieving messages from the server by an internet appliance (Goldfinger, col. 5, lines

25-30).

8.   Regarding claims 7 and 26, Cloutier and Goldfinger show all of the features of

the invention, substantially as claimed, as described in claim 3 and 22, including

deleting a message using an internet appliance without retrieving the message from the

server (col. 6, lines 50-65, Goldfinger teaches authorization for users to decide which

users can send them messages).

9.   Regarding claims 8 and 14, Cloutier discloses an apparatus and system for

providing message notification and allowing a user to instantly review new messages

comprising:

        a message notification application registered to the at least one instant

messaging service, wherein the message notification application includes a buddy list

onto which the user is added, thereby associating the user to one of the at least one

instant message service that the user is currently using (Cloutier, col. 4, lines 15-25,

Cloutier teaches a system for notification of electronically stored messages that may be

implemented using any type of devices capable of receiving a message); and

a server for storing messages and providing a medium for the message

notification application to operate (Cloutier, col. 3, lines 50-61).

Cloutier does not disclose an internet appliance to access the server and receive

an instant message notification from the message notification application via the one

instant messaging service, the instant message notification indicates that a new

message is stored on the server for the user

In an analogous art in the networking field, Goldfinger discloses at least one

instant messaging service (Goldfinger, col. 4, lines 49-60); and

an internet appliance to access the server and receive an instant message

notification from the message notification application via the one instant messaging

service, the instant message notification indicates that a new message is stored on the

server for the user (col. 6, lines 50-65, Goldfinger teaches users on a computer

terminal being able to receive messages). Goldfinger also teaches users having a list

of sought users (col. 6, lines 3-15).

Therefore, it would have been obvious to one in the ordinary skill in the art at the

time of the invention to combine the system for notification and retrieval of electronically

stored messages as disclosed by Cloutier, with the communication system using an

instant messaging service as disclosed by Goldfinger to provide notification from the

message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

10.   Regarding claims 9 and 15, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including further comprising means for automatically adding the user to the buddy list of the message notification application in response to the user signing up to receive messages with the message notification application (Goldfinger, col. 5, line 35 through col. 6, line 25, Goldfinger teaches a list of users updated when they sign on to the system).

11.   Regarding claims 10 and 16, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including wherein the message notification application comprises means for sending the user the instant message notification through the at least one instant messaging service when a message arrives for the user (Goldfinger, col. 6, lines 35-50).

12.   Regarding claims 11 and 17, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including retrieving the message from the server by one of sending a request to the message notification application and using a telephone (Goldfinger, col. 5, lines 24-30).

13.   Regarding claims 12 and 18, Cloutier and Goldfinger show all of the features of

the invention, substantially as claimed, as described in claims 8 and 14, including

wherein the server is one of an application, a voice messaging and a unified messaging

server (Goldfinger, col. 5, lines 30-35).

14.   Regarding claims 13 and 19, Cloutier and Goldfinger show all of the features of

the invention, substantially as claimed, as described in claims 8 and 14, including

deleting the message using the Internet appliance without retrieving the message from

the server (Goldfinger, col. 6, lines 50-65, Goldfinger teaches authorization for users to

decide which users can send them messages).

15.   Regarding claim 27, Cloutier discloses a method of providing a voice messaging

notification application for a user in an instant messaging system comprising the steps

of:

      coupling a message notification application to a server, wherein the server stores

      messages for the user (Cloutier, col. 3, lines 50-61);

      registering the message notification application to at least one instant messaging

service (Cloutier, col. 4, lines 15-25, Cloutier teaches a system for notification of

electronically stored messages that may be implemented using any type of devices

capable of receiving a message);

However, Cloutier does not disclose accessing one of the at least one instant

messaging services by the user;

adding the user to a buddy list of the message notification application, wherein

the buddy list is associated with the one instant messaging service;

sending an instant message notification to the user from the message notification

application via the one instant messaging service when a message arrives on the server

for the user; and

allowing the user access to a server by one of using an internet appliance and

using a telephone.

In an analogous art in the networking field, Goldfinger discloses adding the user

to a buddy list of the message notification application, wherein the buddy list is

associated with the one instant messaging service (Goldfinger, col. 6, lines 3-35,

Goldfinger teaches a server containing a list of connected users which updates the lists

of sought users predefined by users connected to the system);

sending an instant message notification to the user from the message notification

application via the one instant messaging service when a message arrives on the server

for the user (Goldfinger, col. 6, lines 35-50, Goldfinger teaches a server sending a

message to a user when it arrives from another user); and

allowing the user access to a server by one of using an internet appliance and

using a telephone(Goldfinger, col. 5, lines 24-30).

Goldfinger also teaches users having a list of sought users (col. 6, lines 3-15).

Therefore, it would have been obvious to one in the ordinary skill in the art at the

time of the invention to combine the system for notification and retrieval of electronically

stored messages as disclosed by Cloutier, with the communication system using an

instant messaging service as disclosed by Goldfinger to provide notification from the

message notification application via an instant messaging service to the message

recipient when a message arrives on the server for the user for the benefit of providing

instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1,

lines 45-47).

Response to Arguments

16.   Applicant's argument include, the failure of the previously applied art to expressly

disclose, "a server that receives a message intended for a user, and then stores the

message for retrieval by the user, and sending an instant messaging notification from a

message notification application to a user via an instant messaging service currently

being accessed by the user." [see Applicant's response, Paper #7, pages 9 and 10], It

is evident from the detailed mappings found in the above rejection that the prior art of

record, clearly disclose this functionality. Further, it is clear from the numerous

teachings (previously and currently cited) that the provision for receiving a message,

storing the message at the server, and sending an instant message to the recipient

through an instant messaging service is clearly taught. Thus, Applicant's arguments

drawn toward distinction of the claimed invention and the prior art teachings on this

point are not persuasive. It is also clear to the Examiner that the combination of

Cloutier and Goldfinger clearly teach the independent claims of Applicant's claimed
invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time
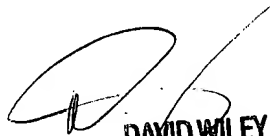policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to J. Bret Dennison whose telephone number is (703) 305-
8756. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number
for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

J.B.D
Patent Examiner
Art Unit 2143

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,113	10/25/2000	Louis Bouchard	LUCENT-01701	3907

28960	7590	10/06/2004

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EXAMINER
DENNISON, JERRY B

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

OCT 0 2004

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Advisory Action	09/697,113	BOUCHARD ET AL.
	Examiner	**Art Unit**
	J. Bret Dennison	2143

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires <u>2</u> months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached.*

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-20 and 22-27*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Applicant's arguments include the failure of previously applied art to expressly disclose teaching a registration process by which the notification application is registered to an instant messenging service. See Response, Filed 19 Aug. 2004, page 8, second paragraph. It is evident from the detailed mappings found in the above rejection(s) that Cloutier et al. teaches a system for notification of electronically stored messages for subscribers, where it is inherent that a registration process must be performed (Cloutier, col. 3, lines 20-30). Cloutier also teaches that the messaging system server provides for integrationg of other messaging servers with the messaging system (Coutier, col. 3, lines 40-50).

Applicant's arguments also include the failure of previously applied art to expressly disclose sending an instant message notification when a message arrives on the server for the user. See Response, Filed 19 Aug. 2004, page 9, second paragraph. It is evident from the detailed mappings found in the above rejection(s) that Goldfinger teaches a server sending a message to a user when it arrives from another user (Goldfinger, col. 6, lines 35-50). Cloutier also teaches the messaging server providing notification of new messages receivd by the server to the subscriber (Cloutier, col 3, line 60 through col. 4, line 5).

Applicant's arguments also include the failure of previously applied art to expressly disclose accessing one of the at least one instant messaging services by the user. See Response, Filed 19 Aug. 2004, page 10, last paragraph. However, Goldfinger does disclose a communication network where users access the communication system to use the instant messaging service (Goldfinger, see Abstract).

Applicant's arguments also include the failure of previously applied art to expressly disclose adding the user to a buddy list of the message notification application. 2004, page 10, second paragraph. It is evident from the detailed mappings found in the above rejection(s) that Goldfinger teaches a server containing a list of connected users which updates the lists of sought users predefined by users connected to the system (Goldfinger, col. 6, lines 3-35). Cloutier also has a list of subscribers to the messaging notification system where the subscribers must provide a password to retrieve stored messages (Cloutier, col. 5, lines 25-40).

Further, it is clear from the numerous teachings (previously and currently cited) that the provision for integrating a messaging service with an instant messaging service to provide messages stored on the server to its subscribers, was widely implemented in the networking art. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to provide notification from the message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	) Group Art Unit: 2143
	)
Louis Bouchard	) Examiner: Dennison, Jerry
	)
Serial No.: 09/697,113	) **AMENDMENT AND RESPONSE TO**
	) **FINAL OFFICE ACTION MAILED ON**
Filed: October 25, 2000	) **April 15, 2004**
	)
For: **INSTANT MESSAGE**	) 162 N. Wolfe Road
NOTIFICATION APPLICATION	) Sunnyvale, CA 94086
	) (408) 530-9700
	)
	Customer No.: 28960

MS: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

AMENDMENTS

<u>Listing of the claims:</u>

1.   (Previously Presented)   A method of providing message notification for a user comprising the steps of:
   a.   coupling a message notification application to a server, wherein the server stores messages for the user;
   b.   registering the message notification application to at least one instant messaging service;
   c.   accessing one of the at least one instant messaging service by the user:
   d.   signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing; and

- 1 -

e.   sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user.

2.   (Canceled)

3.   (Previously Presented)   The method as claimed in claim 1 further comprising the step of retrieving the message by accessing the server.

4.   (Original)   The method as claimed in claim 3 wherein the server is one of an application, a voice messaging and a unified messaging server.

5.   (Original)   The method as claimed in claim 3 further comprising the step of accessing the server by one of sending a request to the message notification application and using a telephone.

6.   (Original)   The method as claimed in claim 3 further comprising the step of retrieving messages from the server by an internet appliance.

7.   (Previously Presented)   The method as claimed in claim 3 further comprising the step of deleting a message using an internet appliance without retrieving the message from the server.

8.   (Previously Presented)   An apparatus for providing message notification and allowing a user to instantly review new messages comprising:
   a.   at least one instant messaging service;
   b.   a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using;
   c.   a server for storing messages and providing a medium for the message notification application to operate; and

d.   an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user.

9.   (Previously Presented)   The apparatus as claimed in claim 8 further comprising means for automatically adding the user to the buddy list of the message notification application in response to the user signing up to receive messages with the message notification application.

10.   (Previously Presented)   The apparatus as claimed in claim 8 wherein the message notification application comprises means for sending the user the instant message notification through the one instant messaging service when a message arrives for the user.

11.   (Original)   The apparatus as claimed in claim 8 further comprising means for retrieving the message from the server by one of sending a request to the message notification application and using a telephone.

12.   (Original)   The apparatus as claimed in claim 8 wherein the server is one of an application, a voice messaging and a unified messaging server.

13.   (Original)   The apparatus as claimed in claim 8 further comprising means for deleting the message using the internet appliance without retrieving the message from the server.

14.   (Previously Presented)   A message notification system that allows the user to instantly review new messages comprising:
a.   at least one instant messaging service;
b.   a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using;

c.   a server for storing messages and providing a medium for the message notification application to operate; and

d.   an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user.

15.   (Previously Presented)   The message notification system as claimed in claim 14 further comprising means for automatically adding the user to the buddy list of the message notification application in response to the user signing up to receive messages with the message notification application.

16.   (Previously Presented)   The message notification system as claimed in claim 14 wherein the message notification application comprises means for sending the user the instant message notification through the one instant messaging service when a message arrives for the user.

17.   (Original)   The message notification system as claimed in claim 14 further comprising means for retrieving the message from the server by one of sending a request to the message notification application and using a telephone.

18.   (Original)   The message notification system as claimed in claim 14 wherein the server is one of an application, a voice messaging and a unified messaging server.

19.   (Original)   The message notification system as claimed in claim 14 further comprising means for deleting the message using the internet appliance without retrieving the message from the server.

20.   (Previously Presented)   A message notification system for a user comprising:
a.   means for coupling a message notification application to a server, wherein the server stores messages for the user;
b.   means for registering the message notification application to at least one instant messaging service;

c.   means for accessing one of the at least one instant messaging service by the user:

d.   means for signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing; and

e.   means for sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user.

21.   (Canceled)

22.   (Previously Presented)   The message notification system as claimed in claim 20 further comprising means for the user to retrieve the message by accessing the server.

23.   (Original)   The message notification system as claimed in claim 22 wherein the server is one of an application, a voice messaging and a unified messaging server.

24.   (Original)   The message notification system as claimed in claim 22 wherein the user accesses the server by one of sending a request to the message notification application and using a telephone.

25.   (Original)   The message notification system as claimed in claim 22 wherein the message is retrieved from the server by an internet appliance.

26.   (Original)   The message notification system as claimed in claim 22 further comprising the step of deleting the message using the internet appliance without retrieving the message from the server.

27.   (Previously Presented)   A method of providing a voice messaging notification application for a user in an instant messaging system comprising the steps of:

a.   coupling a message notification application to a server, wherein the server stores messages for the user;

b. registering the message notification application to at least one instant messaging service;

c. accessing one of the at least one instant messaging services by the user;

d. adding the user to a buddy list of the message notification application, wherein the buddy list is associated with the one instant messaging service;

e. sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user; and

f. allowing the user access to a server by one of using an internet appliance and using a telephone.

<u>REMARKS</u>

The Applicant respectfully requests further examination and consideration in view of the amendments above and the arguments set forth fully below. Prior to this Office Action, Claims 1, 3-20, and 22-27 were pending in this application. Within the Office Action, Claims 1, 3-20, and 22-27 are rejected. Accordingly, Claims 1, 3-20, and 22-27 are currently pending in this application.

<u>Rejections Under 35 U.S.C. § 103</u>

Within the Office Action, Claims 1, 3-20, and 22-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,535,586 issued to Cloutier et al. (hereafter "Cloutier") in view of U.S. Patent No. 6,449,344 issued to Goldfinger et al. (hereafter "Goldfinger"). The Applicant respectfully traverses these rejections.

The present invention is directed to an apparatus for and a method of providing message notification for a user through an instant messaging service. A message notification application 10 is registered to an instant messaging service 14 through an IP Network 16 such as the Internet or a private intranet. The message notification application 10 maintains a buddy list corresponding to the instant messaging service 14. In the case of multiple internet messaging services, a separate buddy list for each instant messaging service is maintained by the message notification application 10. When the user logs onto the instant messaging service 14 using a particular internet appliance 18, the user instructs the message notification application 10 that the user desires to be notified when a new message is received. The message notification application 10 then adds the user to the buddy list corresponding to the instant messaging service 14 used by the user.

When a new message is received, such as by a voice messaging or unified messaging server 12, the message notification application 10 originates an instant message notification and sends the instant message notification to the instant messaging service 14 for delivery to the user. The instant messaging service 14 then transmits the instant message notification to the internet appliance 18 currently used to access the instant messaging service 14 by the user. The message notification application 10 does not directly transmit the instant message notification to the end user. In this manner, the message notification application 10 is not burdened with the added complexity of performing instant messaging services.

For point of discussion, the unified messaging server 12 can be considered a front-end messaging system, that is a messaging system where a message is received and stored. Further, the instant messaging service 14 can be considered a back-end messaging system, that is a messaging system that sends a notification to the end user. Within the Office Action, it is stated that the motivation for adding a notification system of Goldfinger to a messaging system of Cloutier is that Cloutier discloses alerting a user of receipt of a new message by working in conjunction with "other messaging systems". However, such "other messaging systems" of Cloutier reference front-end messaging systems, such as email server 110 that receives email for the user. This is further substantiated in column 1, lines 16-19, in which Cloutier teaches other messaging systems such as voice mail, email, fax services, and "many messaging systems". In contrast, the communications system of Goldfinger uses an information management apparatus 28 and an annunciator 24 to send a notification to a user. Although the Applicant does not believe that such a configuration within Goldfinger is the same as the back-end messaging system of the present invention, for comparison purposes, this configuration of Goldfinger can be considered most analogously to a back-end messaging system since it is providing a notification to the user. Since Goldfinger teaches a back-end messaging system, and the motivation within Cloutier is directed to a front-end messaging system, the motivation to combine Goldfinger with Cloutier is not valid. Therefore, each of the independent claims 1, 8, 14, 20, and 27, which are rejected by the combination of Goldfinger with Cloutier, are allowable.

Further, Cloutier does not teach "registering the message notification application to at least one instant messaging service" as stated in the Office Action. However, the cited passage within Cloutier, column 4, lines 15-25, teaches a messaging system server 120 sending a message notification over the internet 130 to a personal computer 190. In other words, Cloutier teaches sending a notification to an end user access device. Clearly, "sending a notification" and "registering with a service" is not the same. Further, there is no hint, teaching, or suggestion of registering a notification application, such as the messaging system server 120, to a messaging service, such as an instant messaging service, as claimed. Since Cloutier teaches sending a notification directly to an end user, there is no need to configure a registration process to register a notification application with an intermediate instant messaging system. As there is not a need, Cloutier does not teach a registration process by which the notification application is registered to an instant messaging service.

Within the Office Action, it is stated that Goldfinger teaches "accessing one of the at least one instant messaging services by the user", as claimed in the present application. To support

this assertion, column 5, lines 35-50 of Goldfinger is cited, which teaches a notification mechanism that notifies an information management apparatus 28 within a remote server 20 when a user 18 connects to the internet 14. However, Goldfinger teaches that the user 18 establishes a connection to the internet 14, and that is all. The user 18 does not access the server 20. Instead, a notification signal is sent to the server 20. Accessing a service is well known in the art and typically entails logging onto a service or some other method of explicitly connecting the user to the service. The present application teaches a user accessing the instant messaging service 14 via the internet 16 and then logging into the instant messaging service 14 (Specification, page 4, lines 9-10). As such, accessing the service by the user, as claimed in the present application, is not the same as sending a notification signal to the service by an underlying software program within the user's terminal.

Within the Office Action, it is stated that Goldfinger teaches "sending an instant message via the one instant messaging service to the user when a message arrives on the server for the user", as claimed in the present application. To support this assertion, column 6, lines 35-50 of Goldfinger is cited. Within the Office Action, this cited portion is characterized as teaching a server that sends a message to a user when the message arrives from another user. However, there is no hint, teaching, or suggestion within this passage that indicates a message is received by the server 20 for the user 18, or the user 34, as claimed in the present application. Instead, Goldfinger teaches that when another user, user 34, connects to the internet 14, a notification is sent to user 18 that user 34 has connected to the network. There is no message that arrives on the server 20 for the user 18; instead, a notification is generated by the server (annunciator 24) when the user 34 is connected to the interne 14. As such, Goldfinger does not teach sending an instant message notification when a message arrives on the server for the user.

Within the Office Action, it is stated that Goldfinger teaches "signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing". To support this assertion, column 6, lines 3-35 of Goldfinger are cited. The cited passage of Goldfinger teaches a server 20 that includes an information management apparatus 28 that maintains a list of users connected to the internet 14. The present application specifically claims "adding the user to a buddy list of the message notification application". However, if the system of Goldfinger is used to maintain the list of connected users (buddy list), as proposed in the Office Action, then the information management apparatus 28 of the server 20 necessarily must maintain the list of connected users. Therefore, the server 20 maintains the list

of connected users, not the notification apparatus 30. In contrast, the present invention teaches a buddy list of the message notification application, as claimed.

Further, even if the proposed combination of the messaging system of Cloutier and the notification application of Goldfinger is valid, which the Applicant contends is not the case, the proposed combination does not teach the message notification system of the present application as claimed. Cloutier teaches messaging functions that alert a message recipient of the receipt of new messages (Cloutier, col. 3, lines 33-35). This messaging functionality is performed and controlled by a messaging server 120. In other words, any notification functionality resides within the messaging server 120. Goldfinger teaches a notification application, connection notification apparatus 30, that resides in the user terminal 12, which clearly must be remote from any messaging server. Therefore, a combined system of Cloutier and Goldfinger necessarily includes two separate notification applications, one on the remote user terminal (Goldfinger) and on on the messaging server (Cloutier). Two separate and distinct notification applications is not the same as the message notification application of the present invention.

The independent Claim 1 is directed to a method of providing message notification for a user. The method includes coupling a message notification application to a server, wherein the server stores messages for the user, registering the message notification application to at least one instant messaging service, accessing one of the at least one instant messaging service by the user, signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing, and sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user. As discussed above, the combination of Goldfinger with Cloutier is not valid. Further, Cloutier does not teach registering the message notification application to at least on instant messaging service. Still further, Goldfinger does not teach accessing one of the at least one instant messaging services by the user. Further, Goldfinger does not teach sending an instant message notification when a message arrives on the server for the user. Still further, Goldfinger does not teach adding the user to a buddy list of the message notification application. Still yet further, the proposed combination of Goldfinger with Cloutier necessarily includes two separate notification applications, not a single message notification application. For at least these reasons, the independent Claim 1 is allowable over the combination of Goldfinger with Cloutier.

Claims 3-7 are dependent on independent Claim 1. As stated above, Claim 1 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 3-7 are also in allowable as being dependent on an allowable base claim.

The amended independent Claim 8 is directed to an apparatus for providing message notification and allowing a user to instantly review new messages. The apparatus comprises at least one instant messaging service, a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using, a server for storing messages and providing a medium for the message notification application to operate, and an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user. As discussed above, the combination of Goldfinger with Cloutier is not valid. Further, Cloutier does not teach registering the message notification application to at least on instant messaging service. Still further, Goldfinger does not teach accessing one of the at least one instant messaging services by the user. Further, Goldfinger does not teach sending an instant message notification when a message arrives on the server for the user. Still further, Goldfinger does not teach adding the user to a buddy list of the message notification application. Still yet further, the proposed combination of Goldfinger with Cloutier necessarily includes two separate notification applications, not a single message notification application. For at least these reasons, the independent Claim 8 is allowable over the combination of Goldfinger with Cloutier.

Claims 9-13 are dependent on independent Claim 8. As stated above, Claim 8 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 9-13 are also in allowable as being dependent on an allowable base claim.

The amended independent Claim 14 is directed to a message notification system that allows the user to instantly review new messages. The message notification system comprises at least one instant messaging service, a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using, a server for storing messages and providing a medium for the message notification application to operate, and an internet appliance to access the server and receive an instant message notification from the message notification application

via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user. As discussed above, the combination of Goldfinger with Cloutier is not valid. Further, Cloutier does not teach registering the message notification application to at least on instant messaging service. Still further, Goldfinger does not teach accessing one of the at least one instant messaging services by the user. Further, Goldfinger does not teach sending an instant message notification when a message arrives on the server for the user. Still further, Goldfinger does not teach adding the user to a buddy list of the message notification application. Still yet further, the proposed combination of Goldfinger with Cloutier necessarily includes two separate notification applications, not a single message notification application. For at least these reasons, the independent Claim 14 is allowable over the combination of Goldfinger with Cloutier.

Claims 15-19 are dependent on independent Claim 14. As stated above, Claim 14 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 15-19 are also in allowable as being dependent on an allowable base claim.

The amended independent Claim 20 is directed to a message notification system for a user. The message notification system comprises means for coupling a message notification application to a server, wherein the server stores messages for the user, means for registering the message notification application to at least one instant messaging service, means for accessing one of the at least one instant messaging service by the user, means for signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing, and means for sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user. As discussed above, the combination of Goldfinger with Cloutier is not valid. Further, Cloutier does not teach registering the message notification application to at least on instant messaging service. Still further, Goldfinger does not teach accessing one of the at least one instant messaging services by the user. Further, Goldfinger does not teach sending an instant message notification when a message arrives on the server for the user. Still further, Goldfinger does not teach adding the user to a buddy list of the message notification application. Still yet further, the proposed combination of Goldfinger with Cloutier necessarily includes two separate notification applications, not a single message notification application. For at least these reasons, the independent Claim 20 is allowable over the combination of Goldfinger with Cloutier.

Claims 22-26 are dependent on independent Claim 20. As stated above, Claim 20 is allowable over the combination of Goldfinger with Cloutier. Accordingly, Claims 22-26 are also in allowable as being dependent on an allowable base claim.

The amended independent Claim 27 is directed to a method of providing a voice messaging notification application for a user in an instant messaging system. The method comprises the steps of coupling a message notification application to a server, wherein the server stores messages for the user, registering the message notification application to at least one instant messaging service, accessing one of the at least one instant messaging services by the user, adding the user to a buddy list of the message notification application, wherein the buddy list is associated with the one instant messaging service, sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user, and allowing the user access to a server by one of using an internet appliance and using a telephone. As discussed above, the combination of Goldfinger with Cloutier is not valid. Further, Cloutier does not teach registering the message notification application to at least on instant messaging service. Still further, Goldfinger does not teach accessing one of the at least one instant messaging services by the user. Further, Goldfinger does not teach sending an instant message notification when a message arrives on the server for the user. Still further, Goldfinger does not teach adding the user to a buddy list of the message notification application. Still yet further, the proposed combination of Goldfinger with Cloutier necessarily includes two separate notification applications, not a single message notification application. For at least these reasons, the independent Claim 27 is allowable over the combination of Goldfinger with Cloutier.

For the reasons given above, Applicant respectfully submits that the claims are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

Dated: 6-15-04

By: _____

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